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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,341	04/25/2001	Wataru Satake	01255/LH	6960
1933	7590	11/01/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			TRAN, DOUGLAS Q	
767 THIRD AVENUE			ART UNIT	
25TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10017-2023			2624	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/842,341

Applicant(s)

SATAKE ET AL.

Examiner

Douglas Q. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/25/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

#### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on May/08/2000 and June/14/2000. It is noted, however, that the Examiner has not received the certified copies. Please submit the certified copies priorities of documents.
2. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

#### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The limitation of "a specific information sets" from claims 1 to 14; the limitation of "a plurality of associated information sets" from claims 1-5; and the limitation of "a random

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number" render claims to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoshii et al. (US Patent No. 6,655,284 B1).

As to claim 1, Hoshii teaches a method for producing a print, on which a specific image is printed based on a specific information set when a captured image (photo image is captured by the camera on col. 3, lines 52-55) is printed as a visible image on said print based on image data said captured image, comprising the steps of:

reading a plurality of specific information sets (i.e., advertisement contents in fig. 7A) and a plurality of associate information sets (fig. 6-8), both of which are stored server (28 in fig. 4), installed on a network (27 in fig. 4), in such a manner that each of said specific information sets relates to each of said associate information sets in regard to a date and time and/or each of said associate information sets for identifying or classifying said specific information sets (i.e., E1 in fig. 15; col. 5, lines 20-22 and 32-44);

selecting a part of specific information sets out of a plurality of said specific information sets read from said server, based on said associate information sets (E1 in fig. 15 and fig. 16);  
and

printing said specific image, based on said specific information set, on said print on which said captured image (i.e., photo in fig. 13) is also printed (E8 and E9 in fig. 15).

As to claim 2, Hoshii discloses every feature discussed in claim 1, and further teaches the specific information sets are transferred to a printer (1 in fig. 4) from the server (28 in fig. 4) and stored in a memory section provided in the printer (col. 4, lines 34-38).

As to claim 3, Hoshii discloses every feature discussed in claim 1, and further teaches the reading step is performed at constant time intervals (col. 6, lines 24-29).

As to claim 4, Hoshii discloses every feature discussed in claim 1, and further teaches the specific image is printed as a visible image on the print, based on the specific information set (the specific image is printed which is indicated in fig. 18).

As to claim 5, Hoshii discloses every feature discussed in claim 1, and further teaches a kind said specific information set is selected corresponding to customer's information accumulated in advance either said printer or said network (col. 5, lines 33-44).

As to claim 6, Hoshii discloses a method for producing a print, on which a specific image is printed based on a specific information set when an image captured by a customer (photo image is captured by the camera on col. 3, lines 52-55) is printed as a visible image on said print based on image data of said image captured by said customer in a shop, comprising the steps of:

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extracting said specific information set (i.e., advertisement from fig. 6-8) from a memory section (i.e., stored from 28 in fig. 4), in which a plurality of specific information sets are stored, irrespective of said image captured by said customer (i.e., photo in fig. 18); and

printing said specific image, based on said specific information set extracted in the extracting step, on said print on which said image captured by said customer is also printed (E7 to E9 in fig. 15), wherein specific images printed on consecutive prints are different relative to each other (fig. 18 indicates the specific images will be printed on consecutive prints are different relative to each other).

As to claim 7, Hoshii discloses every feature discussed in claim, and further teaches a plurality of the specific information sets are stored in the memory section in such a manner that a priority degree or an order of each of the specific information sets is determined in advance (col. 4, lines 33-44).

As to claim 8, Hoshii discloses every feature discussed in claim, and further teaches the memory section is provided in a server installed on a network (storage device 34 from the server 28 in the network, col. 5, lines 33-35).

As to claim 9, Hoshii discloses every feature discussed in claim, and further teaches the specific image is printed as a visible image on the print, based on the specific information set (E2 in fig. 15 or F4 in fig. 17).

As to claim 10, Hoshii discloses every feature discussed in claim, and further teaches the specific information set is extracted corresponding to customer's information accumulated in advance (col. 5, lines 33-44).

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshii et al. (US Patent No. 6,655,284 B1) and in combination of Farago (US Patent No. 6,747,752 B1).

As to claim 11, Hoshii discloses every feature discussed in claim, and further teaches

Hoshii discloses a method for producing a print, on which a specific image is printed based on a specific information set when an image captured by a customer (photo image is captured by the camera on col. 3, lines 52-55) is printed as a visible image on said print based on image data of said image captured by said customer in a shop, comprising the steps of:

extracting said specific information set (i.e., advertisement from fig. 6-8) from a memory section (i.e., stored from 28 in fig. 4), in which a plurality of specific information sets are stored, irrespective of said image captured by said customer (i.e., photo in fig. 18); and

printing said specific image, based on said specific information set extracted in the extracting step, on said print on which said image captured by said customer is also printed (E7 to E9 in fig. 15), wherein specific images printed on consecutive prints are different relative to each other (fig. 18 indicates the specific images will be printed on consecutive prints are different relative to each other).

However, Hoshii does not teach of extracting the specific information set based on the random number.

Farago teaches of extracting the specific information set based on the random number (fig. 3 indicates value added premiums selected randomly; col. 4, lines 9-14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the step of extracting of Hoshii for extracting the specific information set based on the random number as taught by Farago. The suggestion for modifying the step of extracting in Hoshii can be reasoned by one of ordinary skill in the art as set forth above by Farago because the modified extracting step would increase the flexibility of the printing system for printing the image with the specific image.

As to claim 12, Hoshii and Farago disclose every feature discussed in claim 11, and Farago further teaches the random number is generated in the memory section (col. 4, lines 11-13).

As to claim 13, Hoshii and Farago discloses every feature discussed in claim 11, and Hoshii further teaches the specific image is printed as a visible image on the print, based on the specific information set (E2 in fig. 15 or F4 in fig. 17).

As to claim 14, Hoshii and Farago discloses every feature discussed in claim 11, and Hoshii further teaches a kind said specific information set is selected corresponding to customer's information accumulated in advance (col. 5, lines 33-44).



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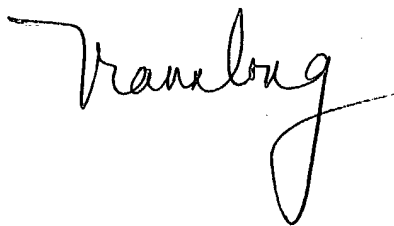
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is [douglas.tran@uspto.gov](mailto:douglas.tran@uspto.gov).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran

Oct. 27, 2004

A handwritten signature in black ink, appearing to read "Tran Douglas", with a stylized flourish at the end.